

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Sauerberg, et al.

Application No.: 10/734,368

Filing Date: December 12, 2003

Atty Docket No. 6594.200-US

Examiner: Rosalynd Ann Keys

Group Art Unit: 1621

Confirmation No.: 2809

Title: Dimeric Dicarboxylic Acid Derivatives, Their Preparation and Use

Mail Stop: Petition
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition of Patent Term Adjustment Indicated in Notice of Allowance

Sir:

The Applicants respectfully submit this Petition, requesting that the Office recalculate the patent term adjustment (PTA) under 35 U.S.C. § 154(b) for the above-captioned application. The Applicants believe that the correct PTA for the application is 676 days. The Applicants proffer the following statements in support of their Petition.

1. The Office mailed a Notice of Allowance in the above-captioned application on February 26, 2010. Attached to the Notice of Allowance was a Determination of Patent Term

Adjustment under 35 U.S.C. § 154(b) that indicated that the total PTA to date is 174 days. As noted above, the Applicants believe that the correct total PTA is 676 days.

2. The Office's PTA determination of 174 days is incorrect because the PTA calculator failed to account for Office delay periods under both 35 USC §§ 154(b)(1)(A) and (B). These two separate Office delay periods should have their days added together in accordance with the reasoning in *Wyeth v. Dudas*, 580 F. Supp. 2d 138 (D.D.C. 2008). The number of PTA credits of 594 days for Office delay under 35 USC § 154(b)(1)(A) and 37 C.F.R. § 1.702(a)(1) set forth on the enclosed PTA History (Exhibit A) is correct, but it only accounts for one of the delays of the Office. The other delay period warrants a PTA credit of 502 days for Office delay under 35 USC § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Because these two periods of delay do not overlap, the Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 1096 days (*i.e.*, 594 days + 502 days) is appropriate based upon Office delay. The total number of PTA debits of 420 days for Applicant delay that is set forth on the enclosed PTA History (Exhibit A) is correct. Thus, the correct total PTA to date is 676 days (*i.e.*, 1096 days minus 420 days).

3. In accordance with 37 C.F.R. § 1.705(b), this Petition is filed no later than the payment of the issue fee, but after the date of mailing of the Notice of Allowance for the instant application.

4. The following statements are required by 37 C.F.R. § 1.705(b)(2)(i).

- i) The correct total PTA credit is 1096 days.
- ii) The 1096 days of total PTA credit is based on PTA credits under both 37 C.F.R. §§ 1.702(a)(1) and (b). A PTA credit of 594 days is due to the Office's failure to mail a notification under 35 USC § 132 or a Notice of Allowance within 14 months of the application's filing date. A PTA credit of 502 days is due to the Office's failure to issue a patent within three years of the filing date of the present application.

5. The following statements are required by 37 C.F.R. § 1.705(b)(2)(ii).

- i) The relevant dates as specified in 37 C.F.R. § 1.703(a)(1) for the first part of the PTA credit are as follows. February 12, 2005 is the date that is fourteen months after the filing date under 35 USC §111(a) (“the fourteen month date”). The date of September 29, 2006 is the mailing date of a Restriction Requirement under 35 USC § 121. Thus, the period of delay runs from February 13, 2005 (one day after the fourteen month date) to September 29, 2006. This period of delay for the first part of the PTA credit is 594 days.
- ii) The relevant dates as specified in 37 C.F.R. § 1.703(b) for the second part of the PTA credit are as follows. December 12, 2006 is the date that is three years after the filing date under 35 USC § 111(a) (“the three year date”). The projected issue date is September 7, 2010. Thus, the period of delay runs from December 13, 2006 (one day after the three year date) to the projected issue date (September 7, 2010) but not including the sum of the exclusionary periods beginning April 28, 2008 and ending on the projected issue date of September 7, 2010. This period of delay minus the exclusionary period for the second part of the PTA credit is 502 days.
- iii) The total PTA under 37 C.F.R. § 1.703(f) is 676 days, which is the total PTA credit for Office delay (594 days + 502 days) minus the total PTA debit for Applicant delay (420 days).

6. Any patent granted on this application is not subject to a terminal disclaimer. See 37 C.F.R. § 1.705(b)(2)(iii).

7. The following statements are required by 37 C.F.R. § 1.705(b)(2)(iv)(A) and list any circumstances during the prosecution of this application constituting a failure to engage in reasonable efforts to conclude processing or examination of the present application as set forth in 37 C.F.R. § 1.704.

- i) The Reply to Notice of Missing Parts filed August 10, 2004 under 37 C.F.R. § 1.53(f) was filed after the three-month period for filing a Response to the Office Action mailed April 15, 2004. Under 37 C.F.R. § 1.704(b), the period of adjustment for delay associated with this Response began on the day after the three month date for response (July 16, 2004) and ended on the date the Response was filed (August 10, 2004). This period of delay is 26 days.
- ii) The Reply After Non-Final Action filed September 6, 2007 under 37 C.F.R. § 1.111 was filed after the three month period for filing a Response to the Office Action mailed March 6, 2007. Under 37 C.F.R. § 1.704(b), the period of adjustment for delay associated with this Response began on the day after the three month date for response (June 7, 2007) and ended on the date the Response was filed (September 6, 2007). This period of delay is 92 days.
- iii) The RCE filed April 28, 2008 under 35 USC § 132(b) was filed after the three month period for filing a Response to the Office Action mailed November 27, 2007. Under 37 C.F.R. § 1.704(b), the period of adjustment for delay associated with this RCE began on the day after the three month date for response (February 28, 2008) and ended on the date the Response was filed (April 28, 2008). This period of delay is 61 days.
- iv) The RCE filed October 14, 2008 under 35 USC § 132(b) was filed after the three month period for filing a Response to the Office Action mailed May 14, 2008. Under 37 C.F.R. § 1.704(b), the period of adjustment for delay associated with this RCE began on the day after the three month date for response (August 15, 2008) and ended on the date the Response was filed (October 14, 2008). This period of delay is 61 days.

- v) The Reply After Non-Final Action filed May 7, 2009 under 37 C.F.R. § 1.111 was filed after the three month period for filing a Response to the final Office Action mailed November 7, 2008. Under 37 C.F.R. § 1.704(b), the period of adjustment associated with this Response began on the day after the three month date for response (February 8, 2009) and ended on the date the RCE was filed (May 7, 2009). This period of delay is 89 days.
- vi) The RCE filed February 9, 2010 under 35 USC § 132(b) was filed after the three month period for filing a Response to the Office Action mailed August 8, 2009. Under 37 C.F.R. § 1.704(b), the period of adjustment for delay associated with this RCE began on the day after the three month date for response (November 9, 2009) and ended on the date the Response was filed (February 9, 2010). This period of delay is 91 days.

8. Fees: The Commissioner is hereby authorized to charge the fee set forth in 37 C.F.R. § 1.18(e) as required by 37 C.F.R. § 1.705(b)(1) and any other fees required by this action or any future action to Deposit Account No. 50-4674.

Respectfully submitted,

Date: May 25, 2010

/Robert S. Dailey/

Robert S. Dailey, Reg. No. 60,753

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10/734,368	Dimeric dicarboxylic acid derivatives, their preparation and use	05-21-2010::10:55:03
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/734,368

Filing or 371(c) Date:	12-12-2003	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	174
USPTO Adjustment(days):	-	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
02-26-2010	Mail Notice of Allowance		
02-25-2010	Document Verification		
02-25-2010	Notice of Allowance Data Verification Completed		
02-25-2010	Case Docketed to Examiner in GAU		
02-12-2010	Date Forwarded to Examiner		
02-09-2010	Request for Continued Examination (RCE)		91
02-12-2010	Disposal for a RCE / CPA / R129		⌘
02-09-2010	Request for Extension of Time - Granted		⌘
02-09-2010	Workflow - Request for RCE - Begin		⌘
08-10-2009	Mail Final Rejection (PTOL - 326)		⌘
08-07-2009	Final Rejection		
06-15-2009	Change in Power of Attorney (May Include Associate POA)		
06-09-2009	Date Forwarded to Examiner		
05-07-2009	Response after Non-Final Action		89
05-07-2009	Request for Extension of Time - Granted		⌘
06-03-2009	Correspondence Address Change		⌘
11-07-2008	Electronic Review		⌘
11-07-2008	Email Notification		⌘
11-07-2008	Mail Non-Final Rejection		⌘
11-05-2008	Non-Final Rejection		
10-29-2008	Date Forwarded to Examiner		
10-29-2008	Date Forwarded to Examiner		
10-14-2008	Request for Continued Examination (RCE)		61
10-29-2008	Disposal for a RCE / CPA / R129		⌘
10-14-2008	Request for Extension of Time - Granted		⌘
10-14-2008	Workflow - Request for RCE - Begin		⌘
05-17-2008	Electronic Review		⌘
05-16-2008	Email Notification		⌘
05-14-2008	Mail Final Rejection (PTOL - 326)		⌘
05-10-2008	Final Rejection		
05-09-2008	Date Forwarded to Examiner		

05-09-2008	Date Forwarded to Examiner	
04-28-2008	Request for Continued Examination (RCE)	61
05-09-2008	Disposal for a RCE / CPA / R129	⌘
04-28-2008	Request for Extension of Time - Granted	⌘
04-28-2008	Workflow - Request for RCE - Begin	⌘
11-28-2007	Electronic Review	⌘
11-27-2007	Email Notification	⌘
11-27-2007	Mail Final Rejection (PTOL - 326)	⌘
11-21-2007	Final Rejection	
09-11-2007	Date Forwarded to Examiner	
09-06-2007	Response after Non-Final Action	92
09-06-2007	Request for Extension of Time - Granted	⌘
03-06-2007	Mail Non-Final Rejection	⌘
03-05-2007	Non-Final Rejection	
01-14-2005	Information Disclosure Statement considered	
01-06-2007	Date Forwarded to Examiner	
12-20-2006	Response to Election / Restriction Filed	
12-20-2006	Request for Extension of Time - Granted	
09-29-2006	Mail Restriction Requirement	594
09-26-2006	Requirement for Restriction / Election	⌘
09-05-2006	Case Docketed to Examiner in GAU	⌘
09-02-2006	Case Docketed to Examiner in GAU	⌘
04-20-2006	IFW TSS Processing by Tech Center Complete	⌘
08-10-2004	Request for Foreign Priority (Priority Papers May Be Included)	⌘
01-14-2005	Reference capture on IDS	⌘
01-14-2005	Information Disclosure Statement (IDS) Filed	⌘
01-14-2005	Information Disclosure Statement (IDS) Filed	⌘
02-19-2004	Reference capture on IDS	⌘
02-19-2004	Information Disclosure Statement (IDS) Filed	⌘
02-19-2004	Information Disclosure Statement (IDS) Filed	⌘
09-10-2004	Application Return from OIPE	⌘
09-10-2004	Application Return TO OIPE	⌘
09-10-2004	Application Return from OIPE	⌘
09-10-2004	Application Is Now Complete	⌘
09-10-2004	Application Return TO OIPE	⌘
09-09-2004	Application Dispatched from OIPE	⌘
09-09-2004	Application Is Now Complete	⌘
08-10-2004	Additional Application Filing Fees	26
08-10-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant	⌘
04-15-2004	Notice Mailed--Application Incomplete--Filing Date	⌘

Assigned

02-17-2004	Cleared by OIPE CSR
01-03-2004	IFW Scan & PACR Auto Security Review
12-12-2003	Initial Exam Team nn

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